

REMARKS

This application has been reviewed in light of the final Office Action mailed September 12, 2006 (“Office Action”). Claims 1, 3-36, 38, 40-42, 44, 46, and 47 are pending. Claims 1, 3-9, 13, 15-17, 21, 23, 24, and 27-34 currently stand rejected. Applicants respectfully request reconsideration and favorable action of all pending claims in view of the following remarks.

Allowable Subject Matter

Applicants respectfully thank the Examiner for the allowance of Claims 35, 36, 38, 40-42, 44, 46, and 47 and for the indication of allowability of Claims 10-12, 14, 18-20, 22, 25, and 26.

Section 103 Rejections Based on Davidson/Pace References

Claims 1, 5, and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,577,862 over Davidson et al. (“*Davidson*”) in view of U.S. Patent No. 4,689,506 to Pace et al. (“*Pace*”). Claims 8, 15, 16, 17, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Davidson* in view of *Pace*, and further in view of U.S. Patent No. 6,385,195 to Sicher et al. (“*Sicher*”). Claims 3, 4, and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Davidson* in view of *Pace*, and further in view of U.S. Patent Publication No. 2003/0063578, listing Weaver as inventor (“*Weaver*”). Claims 9, 13, 23, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Davidson* in view of *Pace*, and further in view of U.S. Patent No. 5,933,495 to Oh (“*Oh*”). Applicants traverse these rejections.

Independent Claim 1 is allowable because *Davidson* and *Pace*, even when combined, fail to disclose, expressly or inherently, “determining that noise is transmitted; in response to the determination, sending a notice of the transmitted noise; receiving the notice of transmitted noise; and in response to the notice, granting priority to an outgoing signal over the transmitted noise.” (Emphasis added). The Office Action relies on column 4, lines 32-33 of *Davidson* as disclosing determining that noise is transmitted. *See* Office Action, page 3. However, this is incorrect. Column 4, lines 32-33 of *Davidson* discloses detecting silence – not transmitted noise:

The method comprises the steps of detecting silence in a communications channel.

(Emphasis added). Furthermore, *Davidson* clearly defines silence as no noise at all:

However, if “true silence,” meaning no noise at all, is transmitted across the network, the parties often misinterpret the absence of noise as an indication of a problem with the communication.

(*Davidson*, column 3, lines 45-48, emphasis added). Therefore, the combination of *Davidson* and *Pace* discloses detecting silence and attenuating an outgoing or incoming signal over the silence. It can not be disputed that silence is not noise. Therefore, *Davidson* and *Pace*, even when combined, fail to disclose, expressly or inherently, “determining that noise is transmitted; in response to the determination, sending a notice of the transmitted noise; receiving the notice of transmitted noise; and in response to the notice, granting priority to an outgoing signal over the transmitted noise.”

Furthermore, the Office Action, in the Response to Arguments section at page 18-19, responds to Applicants’ previous similar argument by contending that “the notice packet is not transmitted noise.” However, Applicants’ Specification discloses transmitted noise. For example, page 14, lines 17-19 of the Specification states:

Notice signal 39 may indicate the production and/or transmission of masked echo signal 37, or insertion of comfort noise 35.

(Emphasis added).

Additionally, the Office Action, in the Response to Arguments section at page 19, responds to the Applicants previous similar argument by contending that “*Pace* does teach giving priority to the outgoing signal over transmitted noise.” However, whether *Pace* teaches “giving priority to the outgoing signal over transmitted noise” (which Applicants do not address here) is irrelevant when *Davidson* is combined with *Pace*. As stated above, *Davidson* clearly only detects silence. Therefore, when *Davidson* is combined with *Pace*, the combination, at the most, merely discloses detecting silence and attenuating an outgoing or incoming signal over the silence.

For at least these reasons, Independent Claim 1 and its dependents should be allowed. Independent Claims 9, 15, and 23 and their dependents should be allowed for analogous reasons.

Section 103 Rejections Based on Nayak/Beyda References

Claims 27, 28, 29, 31, and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0078767, listing Nayak as inventor ("*Nayak*") in view of U.S. Patent No. 5,995,607 to Beyda et al. ("*Beyda*"). Claim 30 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Nayak* in view of *Beyda*, and further in view of U.S. Patent No. 6,745,055 to Iyengar et al. ("*Iyengar*"). Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Nayak* in view of *Beyda*, and further in view of *Sicher*. Applicants traverse rejections.

At the outset, Applicants point out that *Nayak* has an actual filing date (June 5, 2002) after the priority date of the Application (December 31, 2001). Therefore, in utilizing *Nayak* as a reference, Applicants submit that the PTO in establishing a *prima facie* rejection must (1) establish the rejection based on the disclosure of *Nayak*, and (2) include a showing of support in a provisional application to which *Nayak* claims priority. See M.P.E.P. §706.02, Example 2 and M.P.E.P. §2136.03.

Notwithstanding the above, Independent Claim 27 is allowable because the proposed combination of *Nayak* and *Beyda* would render *Nayak* "unsatisfactory for its intended purpose."¹ Clearly, one would not be motivated to combine references in a manner that would make the references unsatisfactory for their intended purpose. Accordingly, there is no suggestion or motivation to make the proposed combination.

The Office Action acknowledges that *Nayak* does not disclose "receiving a status signal at the device indicating that the phone is operating as a speakerphone." See Office Action, page 14. Therefore, the Office Action proposes combining features from *Beyda* to meet this limitation. Particularly, the Office Action indicates that *Beyda* teaches "[a] status signal indicat[ing] that the phone is operating as a speakerphone. See *id.* With this, the Office Action further states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine *Nayak* and *Beyda* because "[a]lthough an Internet telephony call provides a sufficient quality of service for a handset call, the additional ambient noise introduced in a speaker-phone call degrades the voice transmission quality to an unacceptable extent. As such *Beyda*'s scheme makes the voice quality better." See Office Action, page 15 (emphasis added). However, this

¹ See MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

proposed combination renders *Nayak* inoperable for its intended purpose of “managing communication impairments between an Internet Protocol phone (page 1 section 0009, voice telephony) and an Internet Protocol (page 1 section 0009, IP networks) device.” *See* Office Action, page 13 (emphasis added). For example, *Beyda* clearly states:

A call request which includes a request for a speaker-phone call or a conference call triggers the comparison processor to instruct a call router to route a call via the non-Internet telephony trunk . . . In an alternative embodiment, an in-session switch is performed from the Internet telephony trunk to a non-Internet telephony trunk connection in response to an attempted activation of the conference-call feature or the speaker-phone feature during an Internet telephony trunk connection.

See Beyda, Abstract (emphasis added). Therefore, assuming for the sake of argument that *Beyda* teaches a request for a speaker-phone, such a request would cause the call to be removed from an Internet Protocol routing, thereby rendering *Nayak* inoperable.

For at least these reasons, Independent Claim 27 and its dependents should be allowed.

Request for Evidentiary Support

In establishing rejections, if the Examiner is relying upon “common knowledge” or “well known” principles to establish the rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an “Official Notice” or other information within the Examiner’s personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

No Waiver

All of Applicants’ arguments are without prejudice or disclaimer. Applicants reserve the right to discuss the distinctions between the applied art and the claims in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation rejections.

CONCLUSION

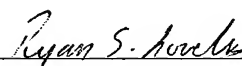
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Ryan S. Loveless, Attorney for Applicants, at the Examiner's convenience at (214) 953-6913.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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